

## **STATUS OF THE CLAIMS**

Claims 1 – 21 are pending.

Claims 1 – 21 stand rejected.

## **REMARKS**

Reconsideration of the subject application is respectfully requested.

Claims 1 – 21 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 – 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Instance (United States Patent No. 4,933,043). Applicant respectfully traverses these rejections and requests their removal for at least the following reasons.

### **35 U.S.C. 112, Second Paragraph Rejections**

Claims 1 – 21 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 stands rejected because “the term ‘selectively’ is relative and therefore indefinite.” Applicant respectfully traverses this rejection for at least the following reasons.

First, Applicant submits the term “selectively” is not a relative term, as it is not a term of degree, for example. Rather as used in Claim 1, the term “selectively” clearly indicates that the overlayer may be unsealed and resealed in a discriminating fashion in use. See, e.g., *page 14, lines 16 – 18 (adhesive 22 present on portion 34 of overlayer 20 facilitates repeated unsealing and resealing of brochure 18 as container 38 is used)*.

Further, even if “selectively” as used was a relative term, that in and of itself is not sufficient to render it impermissibly indefinite. See, e.g., *Seattle Box Co., v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 221 USPQ 568 (Fed.Cir. 1984) *(The fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph.)*; see, e.g., *MPEP 2173.05(b) (Relative Terminology)*. Accordingly, Applicant respectfully requests reconsideration and removal of these rejections.

Claim 8 stands rejected because the “at least one fold line at least partially defining said panels’ [sic] is indefinite. It is unclear how the fold line defines the panels.” Applicant respectfully traverses this rejection.

Claim 1 recites “at least one sheet forming said brochure.” Claim 6, which depends from Claim 1, recites in part, “said brochure comprises one or more at least partially superimposed panels.” Claim 8, which depends from Claim 6, further recites in part, “at least one fold line in said at least one sheet ... at least partially defining said panels.” Thus, Claim 8 clearly and unambiguously recites that at least one fold line in the claimed at least one sheet at least partially defines at least partially superimposed panels. Support for this limitation can be found in the

specification, by way of non-limiting example only, on page 13, lines 6 – 10, wherein it recites:

Those skilled in the art will appreciate that although the above-described embodiments of the brochure are “book-like” in the sense that they have leaves joined at a spine (defined by a fold line), it is within the purview of the invention to provide for a brochure whose panels are joined by spaced parallel fold lines. Such an embodiment of the invention is seen in Figure 13 as designated generally by reference numeral 76.

Wherefore, Applicant respectfully requests reconsideration and removal of this rejection, for at least the foregoing reasons.

Claims 14 and 21 stand rejected because they “describe a ‘relief notch’ but it is unclear what this ‘relief notch’ is and where it is located on the base label. The description of ‘relief notch’ is inadequate in the specification.” Applicant traverses these rejections for at least the following reasons.

First, Applicant submits it is, and was at the time of invention, well understood in the pertinent arts what a “notch” is. Further, Claims 14 and 21 clearly and unequivocally recite that the claimed “base member” comprises the claimed “relief notch”. Thus, the relief notch is properly interrelated to the remaining elements of the claimed label.

Further, for purposes of illustration and by way of non-limiting example only, Examiner’s attention is directed to page 14, lines 10 – 18 of the specification, wherein it recites:

Tab 32 of label 12 depicted in Figures 14, 15, and 17 (shown with a corner turned upward in order to demonstrate the flexibility of tab 32) facilitates the opening of the brochure because it is interposed between

leaf 26 of brochure 18 and container 38, and further, because of *notched opening 82 in base label 16*. When applied to container 38, **relief notch 82** creates a space between leaf 26 and the substrate (such as container 38) to which label 12 is attached. Tab 32 thus provides a convenient "handle" and an aid to gaining access to brochure 18. (*Emphasis added*)

Thus, Applicant respectfully submits ample support exists in the specification for the claimed "relief notch" of Claims 14 and 21. Accordingly, Applicant respectfully requests reconsideration and removal of these rejections.

Applicant further notes no reasons for rejection has been set forth with regard to Claims 15 – 20. Accordingly, Applicant respectfully requests reconsideration and removal of these rejections to these claims inasmuch as no reason for rejection has been cited – in addition to the foregoing reasons should the Examiner believe the foregoing rejections are applicable to one or more of these claims as well.

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Applicant believes that all outstanding reasons of rejection pursuant to 35 U.S.C. 112, second paragraph have been addressed and rendered moot. Nonetheless, should the Examiner persist in any of these rejections, Applicant respectfully requests the Examiner telephonically contact Applicant's undersigned counsel for purposes of resolving such perceived ambiguousness, or suggest amendments which would alleviate the concerns regarding the same, for purposes of expediting prosecution of the present application.

### **35 U.S.C. 103(a) Rejections**

Claims 1 – 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Instance. Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. 103(a) sets forth in part:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

To establish a prima facie case of obviousness, all of the recited claim limitations must be taught or suggested in the prior art. *See, MPEP 2143.03; see also, In re. Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).* Further, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. *See, M.P.E.P. 706.02(j).* Further yet, the teaching or suggestion to make the claimed combination must be found in the prior art, and not based on the applicant's own disclosure. *In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).*

Claim 1 recites, in part, "wherein, a portion of said at least one brochure and overlying member project beyond said first lateral edge of said base member." Applicant respectfully submits Instance fails to teach, or suggest for that matter, a brochure or overlying member that project beyond any edge of a base member --

no less a brochure and overlying member that project beyond a first lateral edge of a base member.

Examiner argues, “Instance discloses an adhesive label which has a base layer (18) ... [and] overlayer (30),” and that “Instance discloses tabs and the panel detaching and reattaching to the **support web** (column 6, lines 34 – 42).” *1/16/03 Office Action*, ¶ 5, lines 1 – 2, lines 9 – 10 (*emphasis added*). Notwithstanding these assertions, Applicant submits that Instance clearly fails to teach that any portion of layer 30 projects beyond layer 18. *See, e.g., Figs. 1, 2, 3, 4, 6, 7, 10.* Rather, Instance clearly teaches that layer 18 forms a boundary within which all other layers adhere, and that no label portion projects beyond. *See, Id.* Further, it can clearly be seen from these figures that no portion of the brochure extends beyond any edge of the layer 18. *See, Id.*

In an attempt to remedy this shortcoming of Instance, Examiner argues, “Instance additionally discloses a label for affixing to a container comprising a series of panels with folded lines and a region extending beyond the edge (column 1, lines 25-43).” *1/16/03 Office Action*, ¶ 5, lines 3 – 5. Applicant respectfully traverses this assertion. Applicant submits these cited portions of Instance instead teach that the support web (layer 18) is dimensioned such that portions thereof extend laterally beyond the edge of the back cover panel – which is plainly inconsistent with that which is claimed, or that the brochure and overlying member extend beyond a lateral edge of the base member. Accordingly, the teachings of Instance in these regards are entirely inconsistent with at least this recited limitation of Claim 1 – at least by virtue that Instance teaches the support web 18

extends laterally with respect to the panels and Claim 1 requires the booklet and overlying member to extend laterally with respect to the base member.

Wherefore, Applicant respectfully submits that as Instance fails to teach, or suggest for that matter, each of the recited limitations of Claim 1, it necessarily fails to render it unpatentably obvious. Reconsideration and removal of these rejections to Claims 2 – 14 is also requested, at least by virtue of these Claims' ultimate dependency upon patentably distinct base Claim 1.

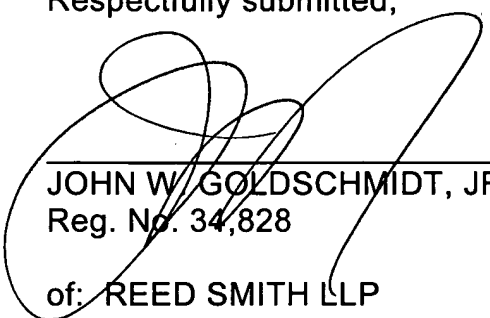
Claim 15 analogously recites in part, "wherein a portion of said at lest one sheet and overlying member project beyond said lateral edge of said base member." Accordingly, reconsideration and removal of this rejection to Claim 15 is requested for at least the foregoing reasons. Reconsideration and removal of these rejections to Claims 16 – 21 is also requested, at least by virtue of these Claims' ultimate dependency upon patentably distinct base Claim 15.

With regard to the Examiner's "product-by-process" analysis, Applicant has carefully reviewed the pending claims and has failed to identify even a single "product by process" claim. With regard to the limitation of "at least one sheet forming said brochure", Applicant submits that this is not a "product by process" limitation but rather merely recites that the claimed at least one sheet forms the claimed brochure.

## **CONCLUSION**

In summation, Applicant respectfully submits that all of the claims presently appearing in this application are in condition for allowance, early notification of which is earnestly solicited. Should there be any questions or other matters whose resolution may be advanced by a telephone call, the Examiner is cordially requested to contact Applicant's undersigned attorney at his number listed below.

Respectfully submitted,



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